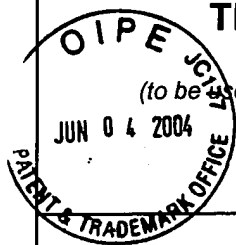


JUN 8 2004

**TRANSMITTAL FORM**

(to be used for all correspondence after initial filing)

Complete if Known

Application Number	07/402,450 <b>TECH CENT</b>
Filing Date	September 1, 1989
First Named Inventor	MURAKAWA et al.
Examiner Name	Ardin H. Marschel
Group Art Unit	1631
Attorney Docket Number	2124-154

Total Number of Pages in This Submission

**ENCLOSURES (check all that apply)**

- |  |   |  |
|--|---|--|
| <input checked="" type="checkbox"/> Fee Transmittal Form                     | <input type="checkbox"/> Assignment Papers  | <input type="checkbox"/> After Allowance Communication to Group                            |
| <input type="checkbox"/> Fee Attached  | <input type="checkbox"/> Drawing(s)   | <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences        |
| <input checked="" type="checkbox"/> Amendment/Reply                          | <input type="checkbox"/> Licensing-related Papers                                       | <input type="checkbox"/> Appeal Communication to Group (Appeal Notice, Brief, Reply Brief) |
| <input checked="" type="checkbox"/> After Final                              | <input type="checkbox"/> Petition   | <input type="checkbox"/> Proprietary Information   |
| <input type="checkbox"/> Affidavits/declaration(s)                           | <input type="checkbox"/> Petition to Convert to a Provisional Application               | <input type="checkbox"/> Status Letter   |
| <input type="checkbox"/> Extension of Time Request                           | <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address | <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below):            |
| <input type="checkbox"/> Express Abandonment Request                         | <input type="checkbox"/> Terminal Disclaimer  | Communication Concerning Rule 129(a) Submission  |
| <input checked="" type="checkbox"/> Information Disclosure Statement         | <input type="checkbox"/> Request for Refund   | Declaration of John J. Rossi, Ph.D.  |
| <input type="checkbox"/> Certified Copy of Priority Document(s)              | <input type="checkbox"/> CD, Number of CD(s)  |  |
| <input type="checkbox"/> Response to Missing Parts/Incomplete Application    |   |  |
| <input type="checkbox"/> Response to Missing Parts under 37 CFR 1.52 or 1.53 |   |  |

REMARKS:

SUBMITTED BY		Complete (if applicable)	
NAME AND REG. NUMBER	Jeffrey L. Ihnen, Reg. No. 28,957		
SIGNATURE		DATE	4 June 2004
		DEPOSIT ACCOUNT USER ID	



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

JUN 8 2004

TECH. CENT. 300/2800

Application No. : 07/402,450  
Applicant : George J. MURAKAWA et al.  
Filed : 1 September 1989  
TC/A.U. : 1631  
Examiner : Ardin H. Marschel  
  
Attorney Docket No. : 2124-154  
Customer No. : 6449

Confirmation No.: 8131

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Phunkett  
2/22/05

BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Director of the United States Patent  
and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450

**COMMUNICATION CONCERNING RULE 129(a) SUBMISSION**

Dear Sir:

Applicants submit that the papers filed concurrently herewith as a first submission under 37 CFR 1.129(a) are appropriate to the facts surrounding the present application and is in accordance with the Board of Patent Appeals and Interferences' Decision on Rehearing dated 29 April 2004 (Paper No. 50) in Patent Interference No. 105,055. In that Decision, the Board concluded that transitional Rule 129(a) practice was a proper avenue for the consideration of the patentability of claim 50 which Applicants had proposed during the interference. See pages 4-7 of the Board's Decision on Rehearing.

Applicants submit that consideration of this first submission under 37 CFR 1.129(a) is consistent with Congress' direction for further examination of certain applications. Specifically, Section 532 of Public Law 103-465 provides for the further limited reexamination of applications. According to this section of the law, the Commissioner is to provide for further limited reexamination of applications that have been pending for 2 years or longer as of June 8, 1995. This provision was enacted by Congress to ease the transition from a patent term of 17 years from issuance to a patent term of 20 years from filing. This provision would be applicable to those

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~~03 FC:2202 369.00 DA~~

applications filed prior to June 8, 1995, so-called "pre-GATT" applications, which had been pending for 2 years or longer as of June 8, 1995. The present application was pending for 2 years or longer as of June 8, 1995, and is thus an application properly subject to Congress' intent for further limited reexamination.

Applicants note that the present claims have not been subject to an appeal subsequent to the enactment of Public Law 103-465. An appeal, including the filing of a Notice of Appeal and Appeal Brief, was taken by Applicants in 1992. An Examiner's Answer was filed in 1993. The Board decided the appeal in 1996 by remanding the application to the Examiner to consider several issues identified by the Board. A decision on the merits was not rendered by the Board. Since the appeal filed in 1992 was taken prior to the enactment of Public Law 103-465, the transitional provisions of 37 C.F.R. § 1.129(a) were not available to Applicants. Thus, Applicants are utilizing the provisions of 37 C.F.R. § 1.129(a) for the first time.

Subsequent to the remand to the Examiner in 1996, Applicants canceled all prior claims, copied claims from Wang et al. (US 5,476,774) and requested the declaration of an interference with Wang et al. Applicants also added a claim directed to a process for quantitation of a target RNA in a sample. The Examiner entered a final rejection of this process claim, and Applicants canceled it in order to proceed to Interference No. 105,055. This process claim has thus been subject to a final rejection and no appeal of this final rejection has been taken, i.e. no appeal brief has been filed with respect to this claim. Accordingly, claims directed to a process for quantitation of a target viral RNA in a sample are properly subject to the transitional provisions of 37 C.F.R. § 1.129(a).

During Interference No. 105,055, the Board concluded that Applicants were not entitled to claims 34-35, 38-39, 42-47 corresponding to the two counts of the interference and entered a Final Judgment against Applicants. This decision by the Board is equivalent to a final rejection by an Examiner. No appeal of the Board's Final Judgment has been taken. Accordingly, these claims are also properly subject to the transitional provisions of 37 C.F.R. § 1.129(a).

Application Serial No. 07/402,450  
Communication Concerning Rule 129(a) Submission Dated 4 June 2004  
Accompanying First Submission Under 37 CFR 1.129(a)

During the interference, Applicants filed a Preliminary Motion to add proposed claim 50 directed to a process for the quantitation of a target viral RNA in a sample. In deciding this Preliminary Motion, the Board concluded that the proposed claim 50 was not directed to the same subject matter as the Wang et al. claims involved in the interference, particularly a Wang et al. claim directed to a process for the quantitation of a nucleic acid in a sample. That is, the Board concluded that proposed claim 50 was not interfering with the Wang et al. claims involved in the interference. In considering Applicants request for rehearing, the Board concluded that the patentability of proposed claim 50 would best be determined by the Examiner and that the transitional provisions of 37 C.F.R. § 1.129(a) would be available to Applicants.

In view of the above facts, Applicants submit that the present application is properly subject to the transitional provisions of 37 C.F.R. § 1.129(a). Reexamination of the present application under 37 C.F.R. § 1.129(a) in view of the papers filed concurrently herewith is requested.

Respectfully submitted,

ROTHWELL, FIGG, ERNST & MANBECK, p.c.

By



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